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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/060,409	04/14/1998	DINAH W. Y. SAH	860098.420	9564

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EXAMINER

BAKER, ANNE MARIE

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 05/15/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory ActionApplication No.
09/060,409

Applicant(s)

Sah et al.

Examiner

Anne-Marie Baker, Ph.D.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Dec. 7, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Dec. 7, 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached sheet.

3. ☒ Applicant's reply ^{would} ~~has~~ overcome the following rejection(s) if entered.
If entered, the proposed amendment to Claim 10 would overcome the rejection of Claim 10 under 35 U.S.C. 112, second paragraph.

4. ☒ Newly proposed or amended claim(s) 10 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
the arguments presented are directed to the claims as amended, but the proposed claim amendments have not been entered.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 6-9, 47, and 48

Claim(s) objected to: 50 and 51

Claim(s) rejected: 10-16, 49, and 52-69

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other: _____

Anne-Marie Baker
ANNE-MARIE BAKER
PATENT EXAMINER

Art Unit: 1632

Advisory Action

(cont.) The proposed claim amendments would require new rejections under 35 U.S.C. 112, first paragraph and 35 U.S.C. 112, second paragraph. For example, Claim 75 would require a new ground of rejection under 35 U.S.C. 112, second paragraph, as being indefinite in its recitation of “detecting a response in the cell” because it is unclear what type of response is to be detected. The claim is also indefinite in its recitation of “therefrom detecting the presence of a protein in the sample” because it is unclear how the “response” correlates with the presence of the protein in the sample. Claims 62 and 63 were rejected for the same claim language. See page 7 of the Office Action of Paper No. 19 (mailed 6/5/01). This rejection has not been addressed in Applicants’ response.

The amendment to Claim 12 introduces new matter into the claims in its recitation of “or inhibition of the activity of the protein encoded by said oncogene.” The specification does not contemplate or teach **inhibiting the activity of the protein** encoded by the oncogene. Applicants point to Examples 2, 3, and 4 as support for this claim amendment (see page 4 of Applicants’ response). However, Examples 2, 3, and 4 do not contemplate and are not directed to inhibiting the activity of the protein encoded by the oncogene.